

REMARKS/ARGUMENTS

Claims 1, 3 – 6, 23, 27 – 29, and 46 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks. Claim 2 was previously cancelled without prejudice or disclaimer. By this Response and Amendment, Claims 1 and 3 are amended, and Claims 11, 12, 14, 24, and 47 are cancelled without prejudice or disclaimer. Claims 7 – 10, 13, 15 – 22, 25, 26, 30 – 33, 36, 38 – 45, 48, and 49 stand withdrawn as being directed to a nonelected invention, and rejoinder is requested in this Response. Of these, Claims 15 and 16 are amended to correct dependencies, while Claims 19 and 42 are amended to correct typographical errors.

In the outstanding Office Action, the Examiner indicated that Claims 3, 6, 23, 27 – 29, 46, and 47 would be allowable if rewritten in independent form and to overcome rejections under 35 U.S.C. 112, second paragraph. This indication of allowable subject matter is noted with appreciation, and has been accordingly acted upon.

The Examiner also: rejected Claims 1, 3 – 6, 23, 24, 27 – 29, 46, and 47 under 35 U.S.C. §112, second paragraph, as being indefinite; and, rejected Claims 1, 4, 5 and 24 under 35 U.S.C. §102(b) as being anticipated by a publication to Mittal titled: “Salt Bath Test for Assesing the Adhesion of Silver to Poly (Ethylene Terephthalate)” (hereinafter referred to as “Mittal”).

By this Response and Amendment, Claim 1 has been amended to recite that “the absorbate is at least one gas.” As this was a feature of withdrawn Claim 14, Claim 14 is accordingly cancelled without prejudice or disclaimer. Claims 1 and 3 have been further amended to address the Examiner’s rejections thereof under 35 U.S.C. §112, second paragraph. These amendments to Claims 1 and 3 are believed to obviate the Examiner’s rejections to these

Appl. No. 10/615,453
Reply to Office Action of January 8, 2007
Attorney Docket No. 25555

Claims, as well as to Claims 4 – 6, 23, 27 – 29, and 46 dependent therefrom. The cancellation of Claims 24 and 47 is believed to obviate the Examiner’s rejections to these Claims. As amended, the Examiner rejection to Claim 1, and thus to all Claims dependent therefrom, is respectfully traversed.

It is respectfully submitted that these amendments do not introduce to this application new matter, within the meaning of 35 U.S.C. §132.

Rejections Under 35 U.S.C. §112, second paragraph

Claims 1, 3, 5, 6, 23, 28, 29, and 46 were rejected under 35 U.S.C. §112, second paragraph for the ambiguous use of the term “critical parameter.”

Claims 24 and 47 were rejected under 35 U.S.C. §112, second paragraph for lacking proper antecedent basis for the terms “the surface roughness,” “the surface reflectivity,” and “the surface scattering behavior.”

Response

Applicants have amended Claims 1 and 3 to clarify the use of the term “critical parameter.” Claims 1 and 3 recite methods of determining adhesion properties or a coating of film of a first material to a substrate of a second material. In Claim 1 the method comprises, *inter alia*, “determining at least partially the amount of absorbate charged at which said coating or film detaches from the substrate *as a critical parameter*” (emphasis added). In Claim 3, the method comprises, *inter alia*, “determining at least partially the substrate curvature resulting where appropriate from charging with the absorbate at which said coating or film detaches from

Appl. No. 10/615,453
Reply to Office Action of January 8, 2007
Attorney Docket No. 25555

the substrate *as a critical parameter*" (emphasis added).

Accordingly, applicants submit that the term "critical parameter" is properly defined in Claims 1 and 3, and thus is sufficiently definite in Claims 5, 6, 23, 28, 29, and 46, which depend directly or indirectly therefrom.

To expedite the application to allowance, Applicants have cancelled Claims 24 and 47 to obviate the Examiner's rejections thereto. Applicants reserve the right to pursue these Claims in one or more continuing applications.

Accordingly, Applicants submit that the above amendments obviate all of the Examiner's rejections under 35 U.S.C. 112, second paragraph.

Allowable subject matter

The Examiner indicated that Claims 3, 27 – 29, 46 and 47 would be allowable if rewritten to overcome all rejections under 35 U.S.C. 112, second paragraph. This indication of allowable subject matter is noted with appreciation.

As discussed above, the above amendments are believed to obviate all rejections to these Claims. Applicants therefore submit that Claim 3, and thus too claims 27 – 29, 46, and 47 dependent therefrom, are in condition for allowance.

Claim 3, like Claim 1, serves as a linking Claim under the presently-imposed restriction. Accordingly Applicants request that, upon allowance of Claim 3, Claims 30 – 45, 48, and 49 should be rejoined and fully examined for patentability.

Rejection under 35 U.S.C. §102(b)

Claims 1, 4, 5 and 24 were rejected as being anticipated by Mittal.

Response

The rejection of Claim 1 is traversed, as Mittal fails to disclose, teach, or suggest all of the features of Claim 1, as amended, and thus of all Claims dependent therefrom.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the Claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the Claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Claim 1, amended, recites a method of determining adhesion properties or a coating of film of a first material to a substrate of a second material. The method comprises, *inter alia*, “charging said coating or film with at least one absorbate...wherein the absorbate is at least one gas.”

As outlined by the Examiner, Mittal discloses a salt bath technique for determining the adhesion properties of at least one coating or film of at least one first material to a substrate of a second material.

In contradistinction to the present Claim 1, Mittal does not disclose, teach, or suggest “charging [a] coating or film with at least one absorbate...*wherein the absorbate is at least one gas*” (emphasis added). In Mittal, the “absorbate” is a liquid salt-water bath, and not a gas.

Appl. No. 10/615,453
Reply to Office Action of January 8, 2007
Attorney Docket No. 25555

Accordingly, Mittal does not disclose, teach, or suggest all of the features of amended Claim 1.

Moreover, Applicants submit that the salt bath test on PET which is disclosed in the Mittal reference is based on a technique which differs significantly from the method recited in Claim 1 and those Claims dependent therefrom. On page 426 of the Mittal reference, for example, it is stated that the salt attacks the interface *between* a silver film and a PET surface (emphasis added). The method disclosed in the Mittal reference is therefore based on an interface detachment by a salt attack. This is a crack-opening procedure, and lacks any real absorption in the film or the substrate. Thus, as the agent or Mittal is not solved inside the film or the substrate, Mittal does not anticipate Claim 1 for the additional reason that it does not disclose, teach, or suggest whatsoever an “absorbate” *per se*.

Furthermore, the method disclosed in the Mittal reference gives an adhesion score (relative detachment) and determines levels of adhesion, but does *not* give a value for the adhesion energy. Thus, Mittal does not anticipate Claim 1 for the additional reason that it does not disclose, teach, or suggest a measurement “the amount of absorbate charged.”

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejection to Claim 1, and thus to Claims 4, 5, 6, and 23, 24 dependent therefrom.

Additionally, Applicants note the Examiner’s indication of Claim 1 as a linking claim. Applicants assert that Claims 7 –10, 13, 15 – 22, 25, and 26, which were previously directed to nonelected inventions, and which all now include the features of allowable Claim 1, should be rejoined and fully examined for patentability.

Claims 11, 12, and 14 have been cancelled without prejudice or disclaimer in view of the amendments to Claim 1. Applicants reserve the right to pursue these Claims in one or more

Appl. No. 10/615,453
Reply to Office Action of January 8, 2007
Attorney Docket No. 25555

continuing applications.

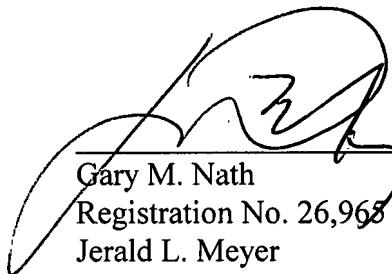
CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
THE NATH LAW GROUP

Date: July 9, 2007
THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314
(703)548-6284



Gary M. Nath
Registration No. 26,968
Jerald L. Meyer
Registration No. 41,194
Matthew J. Moffa
Registration No. 58,860
Customer No. 20529